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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,917

Applicant(s)

MACER ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Appeal Brief, filed 9/16/2005, with respect to the rejection(s) of claims 42-99 under Hawkins have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hawkins et al. (U.S. Patent No. 6,009,458).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 42-44, 46, 49, 51, 57, 60, 62, 67, 70, 73, 75, 81, 94, and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "short-range" in claims 42, 60, 94, and 99 is a relative term which renders the claim indefinite. The term "short-range" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No definition exists in the specification to denote what would be considered a short-range wireless transceiver.

5. The term "more detailed representation" in claims 43 and 63 is a relative term which renders the claim indefinite. The term "more detailed representation" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No definition exists in the specification to denote what would be considered "more detailed", and no comparison has been found to measure the amount of detail against.

6. The terms "potentially available" and "potential swapping transaction" in claims 44 and 67 are relative terms which render the claim indefinite. The terms "potentially available" and "potential swapping

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transaction" are not defined by the claim, the specification does not provided standards for ascertaining the relative degrees, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what is meant by "potential", since "potential" is not a concrete term.

7. The term "time being" in claims 46 and 70 is a relative term which renders the claim indefinite.

The term "time being" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No measurement has been described to provide one of ordinary skill in the art the basis for determining what is the "time being".

8. The term "acceptable swap deal" in claims 46 and 70 is a relative term which renders the claim indefinite. The term "acceptable swap deal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what comprises an "acceptable swap deal", and how the swap deal would be termed "acceptable".

9. The term "potential swap" in claims 49, 57, 73, and 81 is a relative term which renders the claim indefinite. The term "potential swap" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what is meant by "potential", since "potential" is not a concrete term.

10. The term "limited length of time" in claims 51 and 75 is a relative term which renders the claim indefinite. The term "limited length of time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No standard has been provided to denote what is considered a "limited length of time".

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 42-63, 65, 67-86, 88-90, 92, and 94-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins et al. (U.S. Patent No. 6,009,458).

13. In regard to claim 42, Hawkins disclosed *swapping, by way of the transceiver device, signals that are representative of digital game objects for swapping digital game objects between digital object stores of two or more [portable] entertainment machines*. Hawkins was implemented over a wireless network, per column 5, lines 31-37. The users were connected in a peer-to-peer model, per column 5, lines 57-58. Game objects were traded per column 16, lines 28-32.

14. In regard to claim 43, Hawkins was applied as in claim 42. Hawkins further disclosed *displaying a list of the game objects held in the store, and displaying a more detailed representation of a digital game object when that object is selected by a user from the list*. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading. Figures 3A-4B disclosed additional information concerning the objects.

15. In regard to claim 44, Hawkins was applied as in claim 42. Hawkins further disclosed *provid[ing] to the user information on game objects that become potentially available to be acquired from a similar machine that comes within range of the machine, to enable the user to take a decision on whether or not to proceed with a potential swapping transaction*. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.

16. In regard to claim 45, Hawkins was applied as in claim 42. Hawkins further disclosed *being provided by the user with a standing instruction to swap a certain game object or category of game objects in the game object store for another specified game object or category of game objects if such a required object or object category becomes available for swap, and any conditions imposed on the swap by the user are complied with*. See the marketplace description in Hawkins, column 16, line 50 – column 17, line 21.

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17. In regard to claim 46, Hawkins was applied as in claim 42. Hawkins further disclosed *caus[ing] the machine to allocate a retained object portion of the digital object store for storing objects for which the machine user has taken a decision to retain at least for the time being, or for objects for which the user has not yet taken a decision on whether to retain or swap, and to allocate a selected article window portion of the game store in which game objects can be placed for which the user has taken at least a preliminary decision to dispose of provided that an acceptable swap deal can be arranged.* Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.

18. In regard to claim 47, Hawkins was applied as in claim 46. Hawkins further disclosed *operating such that when the user's machine is within range of another similar machine information is transmitted to the other machine to inform the other machine of the content of the selected article window store.* Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.

19. In regard to claim 48, Hawkins was applied as in claim 47. Hawkins further disclosed *causing a display of the machine to comprise a reciprocal display portion adapted to display the content of the selected article window store of another machine which is within range.* Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.

20. In regard to claim 49, Hawkins was applied as in claim 42. Hawkins further disclosed *causing the machine to issue an alert to the user upon the availability of a potential swap.* Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.

21. In regard to claim 50, Hawkins was applied as in claim 42. Hawkins further disclosed *causing the machine to be capable of transmitting an incomplete digital game object for sampling by the user of another machine.* See Hawkins, column 7, lines 18-33. See Hawkins, column 16, lines 50-59.

22. In regard to claim 51, Hawkins was applied as in claim 42. Hawkins further disclosed *causing the machine to transmit a game object for sampling over a limited length of time to facilitate a decision being made as to whether or not the game object is to be acquired by proceeding with a swap transaction.* See Hawkins, column 16, lines 50-59.

23. In regard to claim 52, Hawkins was applied as in claim 42. Hawkins further disclosed *the game object includes a game program, the program comprising code for configuring the machine whereby the*

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current owner of the game can allow the user of another similar machine within range to sample playing of the game by exercising game control over the wireless connection, the game being run on the machine of the current game owner. A demonstration version of a game can be downloaded in column 17.

24. In regard to claim 53, Hawkins was applied as in claim 42. Hawkins further disclosed *configuring the manually operable control to enable the user of the machine to select which game objects are transferred from the retention portion of the store to the selected article window portion of the store and vice-versa. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.*

25. In regard to claim 54, Hawkins was applied as in claim 42. Hawkins further disclosed *configuring the machine to provide a swap proposal indicator for indicating to another, similar machine the swap transaction being proposed. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.*

26. In regard to claim 55, Hawkins was applied as in claim 54. Hawkins further disclosed *the swap proposal indicator comprises a linking indicator function adapted to link the representations of the digital game objects held by the two machines in their selected article window stores, and to communicate that link indicator to the other machine. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.*

27. In regard to claim 56, Hawkins was applied as in claim 55. Hawkins further disclosed *providing a swap approval indicator which is arranged to respond to transmit a response to the other machine in answer to the output of the linking indicator function of the machine which first suggests a swap proposal. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.*

28. In regard to claim 57, Hawkins was applied as in claim 42. Hawkins further disclosed *providing a swap control function arranged to be initiated on acceptance of a proposed swap by a similar such machine. Per column 18, lines 30-47, a Trade Room menu existed to facilitate object trading.*

29. In regard to claim 58, Hawkins was applied as in claim 57. Hawkins further disclosed *providing a swap protocol that ensures that the data objects that have been agreed to be swapped are transmitted simultaneously by the two machines. See Hawkins, column 17, lines 4-15.*

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30. In regard to claim 59, Hawkins was applied as in claim 42. Hawkins further disclosed *configuring the machine for enabling data objects to be loaded into the machine by purchasing transaction from a data object vendor rather than by a data object swapping transaction*. A purchasing marketplace embodiment was provided for in column 16, lines 28-33.

31. Claim 60 has substantially the same limitations as claim 42.

32. In regard to claim 61, Hawkins was applied as in claim 60. Hawkins further disclosed a *visual display*. See Hawkins, column 15, lines 13-16.

33. In regard to claim 62, Hawkins was applied as in claim 61. The trading feature in columns 16-17 made the ability to *display the entire contents of the digital object store* inherent to Hawkins.

34. Claim 63 has substantially the same limitations as claim 43.

35. In regard to claim 65, Hawkins was applied as in claim 60. The presence of a *hand responsive device* was inherent to Hawkins.

36. Claim 67 has substantially the same limitations as claim 44.

37. Claim 68 has substantially the same limitations as claim 45.

38. In regard to claim 69, Hawkins was applied as in claim 68. Hawkins further disclosed *standing instructions include conditions imposed on the swap by the user, the program storing steps for causing the processor, transceiver and digital store to execute the standing instructions only in response to the condition being satisfied*. See Hawkins, column 17, lines 4-15.

39. Claim 70 has substantially the same limitations as claim 46.

40. Claim 71 has substantially the same limitations as claim 47.

41. Claim 72 has substantially the same limitations as claim 48.

42. Claim 73 has substantially the same limitations as claim 49.

43. Claim 74 has substantially the same limitations as claim 50.

44. Claim 75 has substantially the same limitations as claim 51.

45. Claim 76 has substantially the same limitations as claim 52.

46. Claim 77 has substantially the same limitations as claim 53.

47. Claim 78 has substantially the same limitations as claim 54.

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48. Claim 79 has substantially the same limitations as claim 55.

49. Claim 80 has substantially the same limitations as claim 56.

50. Claim 81 has substantially the same limitations as claim 57.

51. Claim 82 has substantially the same limitations as claim 58.

52. Claim 83 has substantially the same limitations as claim 59.

53. In regard to claims 84-85, Hawkins was applied as in claim 60. Hawkins further disclosed *the game object input comprises a reader adapted to read a physical storage medium, the program storing steps for causing the reader to load purchased game objects into the machine store, wherein the program includes steps for disabling the storage medium following reading of the medium.* See Hawkins, column 15, lines 8-11.

54. Claim 86 has substantially the same limitations as claim 83.

55. Claim 88 has substantially the same limitations as claim 52.

56. In regard to claim 89, Hawkins was applied as in claim 88. The additional limitations of claim 89 are covered in column 17, lines 44-65 and column 18, line 55 – column 19, line 25 of Hawkins.

57. In regard to claim 90, Hawkins was applied as in claim 88. Hawkins further disclosed a *game feature for assisting a player to play a game.* See the communications chat function of column 19, lines 1-25.

58. In regard to claim 92, Hawkins was applied as in claim 60. Hawkins further disclosed *the digital game object includes an enhancement to the functionality of the machine.* All of the objects in Hawkins were used for gaming, which was *an enhancement to the functionality of the machine.*

59. Claim 94 has substantially the same limitations as claim 60.

60. In regard to claim 95, Hawkins was applied as in claim 61. Hawkins further disclosed *the store stores information enabling the game objects to be stored in the form of a decorative virtual card or token, the program steps for controlling the store, processor and display including steps for causing the display to display the game object in the form of the decorative virtual card or token.* See Hawkins, column 7, lines 18-33.

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61. In regard to claim 96, Hawkins was applied as in claim 61. Hawkins further disclosed *the store stores information enabling the game objects to be stored in the form of a moving image, the program steps for controlling the store, processor and display including steps for causing the display to display the game object in the form of the moving image.* See Hawkins, column 7, lines 18-33.

62. In regard to claim 97, Hawkins was applied as in claim 61. Hawkins further disclosed *the store stores information enabling the game objects to be stored in the form of a moving image and associated textual information, the program steps for controlling the store, processor and display including steps for causing the display to display the game object in the form of the moving image and associated textual information.* See Hawkins, column 7, lines 18-33.

63. In regard to claim 98, Hawkins was applied as in claim 61. Hawkins further disclosed *the store stores information enabling the game objects to be stored in the form of a moving image and associated audio information, the program steps for controlling the store, processor, and display including steps for causing the display game to display the game object in the form of the moving image and associated audio information.* See Hawkins, column 7, lines 18-33.

64. Claim 99 has substantially the same limitations as claims 42-59.

Claim Rejections - 35 USC § 103

65. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

66. Claims 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins.

67. In regard to claim 64, Hawkins was applied as in claim 60. Hawkins failed to disclose voice activation technology, but voice activation technology was well known in the art at the time of the invention and applied in many computing situations to assist visually impaired persons. Therefore it

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would have been obvious at the time of the invention to upgrade the Hawkins invention with voice activation technology to help the visually impaired fully use the invention.

68. In regard to claim 66, Hawkins was applied as in claim 60. Hawkins failed to disclose that the size of the equipment was *such that the housing can be put in a clothes pocket of the user*. However, miniaturization was commonly used in electronic equipment at the time of the invention by one of ordinary skill in the art to allow for greater portability of an electronic device. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the Hawkins device in any size architecture, including a pocket sized device.

69. Claims 87, 91 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins as applied to claims 86 and 61 above, and further in view of Hawkins et al. (U.S. Patent No. 6,516,202, hereafter referred to as VisorPhone).

70. In regard to claims 87 and 91, Hawkins was applied as in claims 86 and 61. Hawkins disclosed a network system that used wireless technology (column 5, lines 30-37) with a computing device not limited to a computer with a display (column 5, lines 55-64) such as a PDA. Hawkins failed to disclose the ability to incorporate cellular phone technology into the system. However, Visorphone disclosed an expansion system for a personal organizer or computing device with a display that expanded the device to include the functionality of a cellular telephone. See Visorphone, Abstract. In order to allow ease of connection to a wireless network anywhere including a cellular network, it would have been obvious to one of ordinary skill in the art to use the expansion capabilities of Visorphone with the Hawkins device.

71. In regard to claim 93, Hawkins in view of Visorphone was applied as in claim 91. It would have been further obvious to one of ordinary skill in the art to use downloadable ring tones with a cellular telephone to allow customization of the phone system.

Conclusion

72. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murphy et al.

U.S. Patent No. 6,314,468

Utsumi


U.S. Patent NO. 5,966,451

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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